



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ali LAAYOUN et al.

Confirmation No.: 8406

Allowed: December 23, 2004

Group Art Unit: 1637

Application No.: 09/736,151

Examiner: J. Tung

Filed: December 15, 2000

Docket No.: 104959

For: PROCESS FOR LABELING A NUCLEIC ACID

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants provide the following comments regarding the Examiner's Statement of Reasons for Allowance, set forth in the Notice of Allowance mailed December 23, 2004.

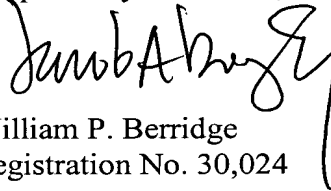
Two portions of the Statement of Reasons for Allowance appear to inadvertently mischaracterize the scope of at least allowed, independent claims 3 and 16. With respect to the allowed claims, the Statement reads: "... no prior art has been found teaching or suggesting the method of fragmenting and labeling synthetic or natural DNA, RNA or chimeric DNA-RNA polymer in which the method applies chemically fragmenting ... attaching a labeling agent ... then subjecting to an *in vitro* nucleic acid amplification." Notice of Allowance, p. 3, ll. 6-12 (emphasis added). This portion of the Statement might be interpreted as incorrectly suggesting that *in vitro* nucleic acid amplification must occur temporally after fragmenting and labeling in independent claims 3 and 16. The Statement also reads: "... neither Morrow nor Mirzabekov et al. disclose fragmenting and labeling DNA, RNA or chimeric DNA-RNA polymer in an *in vitro* amplification." Notice of Allowance, p. 3, ll. 18-19 (emphasis added). This portion of the Statement might be incorrectly interpreted as suggesting that independent claims 3 and 16 distinguish over the

Morrow and Mirzabekov references by reciting that fragmenting and labeling occur during *in vitro* amplification.

Applicants submit that allowed, independent claims 3 and 16 (a) do not recite that *in vitro* nucleic acid amplification occurs after fragmenting and labeling, and (b) do not recite that fragmenting and labeling occur during *in vitro* amplification. Each of claims 3 and 16 recites "... obtaining a mixture in which the [analyte] has been subject to an *in vitro* nucleic acid amplification reaction; chemically fragmenting ... [and] attaching a labeling agent...." Nowhere do claims 3 and 16 require that *in vitro* nucleic acid amplification occur after fragmenting and labeling, or that fragmenting and labeling occur during *in vitro* amplification.

Applicants submit that the language of allowed, independent claims 3 and 16 is clear, and that the claims are patentable over the art of record on the basis of that language alone. The possible inaccurate interpretations of the Statement described above should not be relied upon to misconstrue the claims in any future proceeding.

Respectfully submitted,



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Date: February 23, 2005

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